

### **REMARKS**

Applicant has carefully reviewed and considered the Office Action mailed on May 6, 2003, and the references cited therewith. By this amendment, claims 7-9 and 11 are amended, and claims 1-6 and 10 are canceled. As a result, claims 7-9 and 11 are now pending in this application. Reconsideration of this application in view of the amendments and the following remarks is requested.

#### **I. Objection to the Specification**

**Objection:** In the Office Action of May 6, 2003, the specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. Correction of the following was required: The controller causes the scan module to print copies of a different size on an additional sheet when the Photo Package entry is selected, found in claims 8 and 11, is subject matter that lacks antecedent basis because they are not in the specification.

**Response to Objection:** In this amendment, the following was added to the paragraph starting on line 5 of page 6 of the specification:

“If, for example, the Photo Package includes different sized photos the controller causes the scan module to print copies of a different photo size on an additional sheet when the Photo Package entry is selected.”

It should be noted that this is not new matter. This language is based on the claims as originally filed. The claims as originally filed are part of the specification.

In addition, the specification already included support for the fact that the Photo Package entry as one of the entries that is displayed in response to entering the Photo Features function (See page 4, lines 19-27). The specification also already included support for printing out different sized copies on different sheets in response to selecting the Photo Package entry (See page 5, lines 8-12).

As a result, the amendment to the specification made herein as well as the support already in the specification provide the appropriate support in the specification section of the application to overcome the objection to claims 8 and 11.

## **II. §102 Rejection of the Claims**

**Rejection:** Claims 1, 4, 6 and 9 were rejected under 35 USC § 102(e) as being anticipated by Jamzadeh (U.S. 5,889,578).

**Response:** By this amendment, claims 1, 4, and 6 were cancelled thereby obviating the rejection of these claims under 35 USC § 102(e). In addition, claim 9 was amended to depend on claim 8. Claim 8 was objected to and indicated as allowable if amended to include the limitations of the base claim and any intervening claim. Claim 8 was so amended and therefore in allowable form. Claim 9 as now amended includes the limitations of the claim 8 and therefore is also in allowable form.

## **III. §103 Rejection of the Claims**

**Rejections:** In the Office Action of May 6, 2003, the Examiner made the following rejections to the following claims under 35 USC § 103(a):

Claim 2 was rejected under 35 USC § 103(a) as being unpatentable over Jamzadeh as applied to claim 1 above, and further in view of Hicks (U.S. 4,862,200).

Claim 3 was rejected under 35 USC § 103(a) as being unpatentable over Jamzadeh as applied to claim 1 above, and further in view of Collard (U.S. 6,236,473).

Claim 5 was rejected under 35 USC § 103(a) as being unpatentable over Jamzadeh as applied to claim 1 above, and further in view of Yamada (U.S. 4,847,662).

Claim 7 was rejected under 35 USC § 103(a) as being unpatentable over Jamzadeh as applied to claim 6 above, and further in view of Ishikawa et al. (U.S. 6,183,933).

Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Jamzadeh (U.S. 5,889,578) in view of Yamada (U.S. 4,847,662) and Collard (U.S. 6,236,473).

**Response:** By this amendment, claims 2, 3, 5 and 10 were cancelled thereby obviating the rejection of these claims under 35 USC § 103(a). Claim 7 was amended to depend from now allowable claim 8. Therefore, 7 includes the limitations of claim 8 by its dependency and is also allowable.

**IV. Allowable Subject Matter**

Claims 8 and 11 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. By this amendment, claims 8 and 11 were amended to allowable form.

**V. Miscellaenous Remarks**

By this amendment, claims 1-6 and 10 were canceled so that the allowable claims would pass to issue. The cancellation of claims 1-6 and 10 is without prejudice. The cancellation is not for overcoming the art cited by the Examiner. In fact, Applicant reserves the right to reintroduce the claims in a continuing application.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/442676

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Title: DIGITAL COPYING MACHINE INCLUDING PHOTO FEATURES FUNCTION

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Dkt: 10991815-1

Conclusion

Reconsideration of the application as amended is requested. Applicant respectfully submits that the claims are in condition for allowance and an early notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6977) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 31 day of July, 2003.

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